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| EXAMINER |
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PATEL, JAGDISH

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| ART UNIT | PAPER NUMBER |
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3624

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,255

Applicant(s)

JOHNSON, KEN

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 12/3/03.

Response to Amendment

2. The specification has been amended per request. Claims 1, 7, 10, 14, 17 and 20 have been amended per request.

Response to Arguments

3. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejections.

Statute Cited in Prior Action

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 and 10-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the quote" in limitation e). There is insufficient antecedent basis for this limitation

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in the claim. Although, the preamble, recites, "generating a quote" as a stated objective of the claim, there is no limitation which recites this limitation. Therefore, it is unclear as to how this limitation (e) relates to any other limitation. For examination purpose it is assumed that the terms "payment terms" and "quote" are equivalent.

8. Dependent claims 2-6 also inherit this deficiency.

9. Claim 10 recites the limitation "a server adapted to ..receive terms of a lease from the user interface.." in limitation b). There is insufficient antecedent basis for this limitation in the claim. Step a) recites "a user interface, capable of allowing a user to ..input lease related information.." .

10. Claim 10 step (b) is interpreted as "a server adapted to electronically receive the lease related information from the user interface, store the information, process the information, and generate reports indicating the quote;"

11. Dependent claims 11-13 also inherit this deficiency.

12. Claim 14 recites the limitation "a server adapted to ..receive identification information from the user interface.." in limitation b). There is insufficient antecedent basis for this limitation in the claim. Step a) recites "a user interface,

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capable of allowing a user to alter lease related information..".

13. Claim 14 step (b) is interpreted as "a server adapted to electronically receive the lease related information from the user interface, store the information, process the information, and generate reports indicating the quote;"

Dependent claims 15-16 also inherit this deficiency.

Claims 17-19 contain similar deficiency as claims 14-16.

Claim Rejections - 35 USC § 103

14. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire (Saturn Takes a Major Steps Forward in On-Line Electronic Commerce), April 30, 1998 (Newswire) and further in view of Lockwood (US 6,289,319).

Per claim 1, Newswire discloses an automated method for generating a quote for a piece of leased equipment, (vehicle selection and pricing), the method comprising:

(a) electronically soliciting from a client terms for a lease for a piece of leased equipment ... (Saturn interactive pricing center offers lease terms that fit user's budget p.1, .."a Saturn guest can ..change financing terms and can see ..");

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(b) electronically receiving and storing... the terms for the lease (inherent to Saturn interactive pricing center as disclosed which is Internet based implemented via the disclosed web site www.saturn.com, in which case the client specified terms for a lease of a vehicle are received at a web server);

(c) computing payment terms based for the lease based on the terms of the lease and a desired rate for the lease ("Saturn guest" can see payment terms in response to selected changes in payment terms and can adjust lease terms to fit their budget) and;

(d) generating report at the client showing the payment terms for the lease (Saturn interactive pricing center generates a report showing the payment terms for the lease because the client is able to interact with the Saturn web site to receive lease term information).

The Newswire article which recites an interactive, web-based method for automatically generating a quote for a leased equipment, however, fails to teach that the lease terms solicited include a cost and residual value and down payment information.

Official notice is taken that a cost and residual value and down payment, term for the lease (months or years), down payment

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and residual value are old and well known parameters. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newswire so a plurality of terms and conditions are available to a client for selecting a lease product because it would allow a client to customize a lease that best meets his financial requirements.

Newswire and the official notice fail to disclose the step of altering the quote (payment terms) depending on results of a credit check.

Lockwood, in the same field of endeavor, discloses an automated method of generating a quote (terms of loan) based on the results of the individual clients (abstract, and col. 2 L 59- col. 3 L 29, refer to loan process which requires credit rating of the client).

It would have been obvious to one of ordinary skill in the art at the time of invention to provide the capability of altering the quote (terms of lease) depending on the results of a credit check because it would provide the terms of lease consistent with the client's credit worthiness, i.e. low risk client's clients whose credit rating is superior would receive more favorable terms of the lease.

Claim 2: the act of generating documentation for the piece of leased equipment such a user may complete the documentation (p.2 summary of the finances selected, which may be used by a dealer to complete a sale of a vehicle).

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Claims 3 and 4 : terms for lease include a capital cost, a residual, a dealer fee, a documentation fee, upfront fees, length of lease in months and type of asset (these are customary items of a lease agreement and are anticipated by the applied references). Claim 4 is similarly analyzed as claim 3.

Claim 5: ..receiving the terms for the lease Over the Internet (inherent in Newswire because the method for generating a quote is implemented over the Internet).

Claims 6: Newswire (or alternatively Dykstra) fails to teach that electronically receiving the information through an interactive telephone response system. However, official notice is taken that conducting business transactions over the interactive telephone response system (such as receiving quotes for merchandise, ordering merchandise, catalogue ordering) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to carryout the lease process as disclosed in Newswire reference using an interactive telephone response system (as an alternative to the Internet access) because allowing access over the interactive telephone response system would enable clients who do not have access to a networked computer system to access the leasing system via a telephone network such as PBX. This

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would also thus allow more potential customers access to the lease server.

15. Claims 7-9, 11, 12 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire as applied to claim 1 and further in view of Dykstra and further in view of Lockwood.

Claim 7: Refer to claim 1 analysis for limitations (a)-(e). Note that instruction from a client to go forward with the lease is inherent Newswire as being the case when the terms of the lease were acceptable.

Steps (f) through (j) are customary steps for determining credit worthiness for lease or purchase of a property. Newswire fails to disclose these steps. However, in the same field of endeavor, Dykstra teaches an automated method of credit evaluation and loan processing system. Dykstra teaches:

(f) and (g) electronically soliciting from the lessee... the client basic identification information...individual user of the leased vehicle [col. 4 L 42-47; information pertaining to the potential borrower]; for receiving and storing in the server the client basic identification information, [col. 4 L 42-52, loan application database 108];

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(h) scoring the lessee's credit using external credit score checking databases (refer to steps 110-114 of Fig. 2A, also refer to col. 4 last paragraph);

(i) and (j) providing a credit report to the client detailing a credit score for the lessee and generating documentation for the vehicle lease such that the user at the client may complete the documentation (col. 5 L 3-24 credit report is displayed to the point of purchase terminal 26, the decision is sent to the merchant..the borrower can take a copy of the approval to the lender for verification and sign the papers for the loan).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Newswire and Dykstra references for their respective teachings so as to obtain a comprehensive method that would provide to the client payment terms for a customized lease (based on selected lease terms of personal choice) and subsequently apply for credit for a selected lease and complete the lease transaction based on the credit report provided to the client.

Newswire and Dykstra references as discussed above fail to recite altering the terms for the vehicle lease depending of the results of the credit report. However, Lockwood teaches that the terms of a lease depends on the credit rating (treated as a

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credit report in this context). Lockwood teaches that customarily consumer loan (or lease) processing and its outcome depends on the financial profile (i.e. the credit rating of the consumer).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the capability of altering the quote (terms of lease) depending on the results of the credit report as per Lockwood, because it would provide the terms of lease consistent with the client's credit worthiness, i.e. low risk client's clients whose credit rating is superior would receive more favorable terms of the lease.

Claim 8. Refer to claim 5 analysis.

Claim 9. Refer to claim 6 analysis.

16. Claim 10 is rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Newswire.

Claim 10: Newswire discloses an automated system for generating a quote for a piece of leased equipment (vehicle), the system comprising:

A user interface (the vehicle selection and pricing system allows user to add or delete options or change financing

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terms, see p. 1, also it is noted that the use interface is capable of allowing the);

A server adapted to electronically receive terms of a lease from the user interface, store the terms, process the terms and generate reports (see p.1 the vehicle selection and pricing system is Internet based, inherently the web site www.saturn.com is a server which receives the financing terms, the server also stores this information because it allows the user to send the "information" to a local retailer, the server also processes the terms and generates quote in the form of payment terms as it responds to the user's changing the terms of the lease);

A communication path ... (inherent to a web based automated system of www.saturn.com).

The Newswire doesn't expressly show that the user interface is capable of allowing a user to interactively input lease related information and alter the lease related information depending on the results of an automated credit check. However, it is noted that functionality of the user interface does not functionally relate to any other limitation of the system, i.e. limitations (b) and (c) would function as per the claimed invention regardless of the capabilities of the user interface as recited. Also it is noted that the user interface is capable of performing certain function does not means it

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actually performs such functions. Therefore this limitation is the attributes of the user interface is directed to the information content qualify as *descriptive material*.

However these differences are only found in the *nonfunctional descriptive material* and are not *functionally* involved in the other recited means of the system (server or communication path) as explained. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included any type of user interface which would provide the terms of the lease because the claimed user interface does not functionally relate to the system claimed and because the intended use of the user interface do not patentably distinguish the claimed invention.

Claim 11: Refer to analysis of step (h) of claim 7. All other limitations have been discussed in claim 10 analysis.

Claim 12: an external server for communication between the user interface and the server.

Newswire, fails to disclose external server between the user interface and the server. However, in the same field of endeavor, Dykstra teaches an automated system for generating a quote for a leased equipment. (abstract) including an external server as per claim (refer to Fig. 1 block 38 is a credit bureau computer). It would have been obvious to one of ordinary skill

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in the art at the time of invention to have communication between the user interface and the server so as to determine credit analysis and/or determine eligibility of the user to complete the lease transaction. All other limitations of claim 12 have been analyzed as in claim 10.

Claim 13. refer to claim 1 analysis in combination with claim 10 analysis.

17. Claims 14-19 are rejected under 35 U.S.C. 102(b) as being clearly by anticipated by Dykstra et al. (US Pat. 6,029,149).
(Dykstra)

Claim 14: Dykstra discloses an automated system for generating a credit report for a lessee of a piece of leased equipment, the system comprising:

A user interface (terminals 26 communicating with central processing unit 10);

A server adapted to electronically receive identification information from the user interface, store the information, process the information and generate credit reports (central processing unit 10, refer to detailed description for functionalities claimed in particular loan application database 108);

A communication path ... (col. 3-4 L 57-, refer to data communication link).

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Refer to claim 14 for further analysis of non-functional recitation of element (a). Note that the user interface being capable of allowing the user to interactively alter lease related information has no relationship to functionality of elements (b) a server and (c) a communication path. Therefore, the emended limitation is rendered non-functional and therefore analyzed as such. Please refer to claim 10 analysis for further explanation.

Claim 15. an external server for communication between the user interface and the server (Fig. 1 credit bureau computers 38).

Claims 16. a second communication path electronically linking the server to an external data source (Fig. 1 credit bureau link 36).

Claim 17. is analyzed as per claim 14 as reciting a non-functional limitation "...capable of ..". Note that no patentable weight is accorded to "a quote for leased equipment" because no claim limitation supports this objective. The claim is treated as being directed to generating credit report

Claim 18 and 19 have analyzed as per claims 15 and 16 respectively.

All limitations of system claim 20 have been analyzed as per corresponding method claim 7.

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All limitations of claim 21 and 22 have been analyzed as per claims 15 and 16 respectively.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

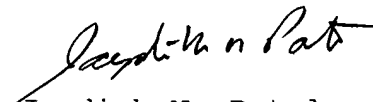
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

December, 22, 2003